

AMENDMENT UNDER 37 C.F.R. § 1.114
U.S. APPLN. NO. 09/615,705
ATTORNEY DOCKET NO. Q60098

REMARKS

Claims 1-13, 15, 17, 19 and 21-32 have been examined on their merits.

The Examiner indicates that claims 2, 4-7, 9, 11, 13, 15, 17 and 19 are withdrawn from consideration.

Also, Applicant amends claim 26 to remove an antecedent basis error. The amendment to claim 26 was not made for reasons of patentability, since the pending rejection against claim 26 is an art-based rejection, and is not a rejection under 35 U.S.C. § 112, second paragraph. The amendment to claim 26 does not raise any new issues requiring further search and/or consideration by the Examiner, and removes a potential issue for appeal. *See* MPEP § 714.13. Entry and consideration of the amendment to claim 26 is respectfully requested.

Applicant herein adds new claims 33 and 34. Support for new claims 33 and 34 can be found at, for example, page 19, lines 2-8 of the instant specification.

Claims 1-13, 15, 17, 19 and 21-34 are all the claims presently pending in the application.

1. Claims 3, 8, 9, 10 and 12 stand rejected under 35 U.S.C. § 112, second paragraph as allegedly being indefinite due to their dependency from a non-elected independent claim.

Applicant herein amends claims 3, 8, 9, 10 and 12 to remove the multiple dependency from claims 1 and 2. Claims 3, 8, 9, 10 and 12 now depend only from claim 1, which was elected for prosecution by the Applicant in the Response to Election of Species Requirement filed on March 21, 2001. Applicant also herein amends claims 8, 9, 10 and 12 to correct antecedent basis. The amendments to claims 8, 9, 10 and 12 to correct antecedent basis were not made for reasons of

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patentability, since the pending § 112, second paragraph rejection of claims 8, 9, 10 and 12 is based upon the multiple dependency of claims 8, 9, 10 and 12. The antecedent basis amendments to claims 8, 9, 10 and 12 were made merely to more accurately claim the present invention and do not narrow the literal scope of the claims as originally filed. The antecedent basis amendments to claims 8, 9, 10 and 12 were not made for reasons of patentability. Both the dependency amendments to claims 3, 8, 9, 10 and 12 and the antecedent basis amendments to claims 8, 9, 10 and 12 do not raise any new issues requiring further search and/or consideration by the Examiner, and remove potential issues for appeal. *See* MPEP § 714.13. Entry and consideration of the amendments to claims 3, 8, 9, 10 and 12 is respectfully requested.

3. Claims 1, 3, 8, 10, 12, 21-23 and 25-32 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Furuya (JP Heisei 11-154733). Applicant traverses the rejection of claims 1, 3, 8, 10, 12, 21-23 and 25-32, and insofar as the rejection applies to new claims 33 and 34, for at least the reasons set forth below.

Applicant has overcome the Examiner's previous arguments with respect to Ozaki et al. (U.S. Patent No. 4,456,939), Miller (U.S. Patent No. 5,255,146), Cohn et al. (U.S. Patent No. 5,535,134), Puar (U.S. Patent No. 4,786,956) and Igarashi (U.S. Patent No. 4,656,491).

Furuya discloses, *inter alia*, a capacitor (613) coupled between a V_{DD} wire (605) and a V_{SS} wire (604). A MOS device (609) is connected in parallel with the capacitor (613). *See* Figure 6 of Furuya.

The initial burden of establishing that a claimed invention is *prima facie* obvious rests on the

USPTO. *In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984). To make its *prima facie* case of obviousness, the USPTO must satisfy three requirements:

1. The prior art relied upon, coupled with the knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated to artisan to modify a reference or to combine references. *In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988).
2. The proposed modification of the prior art must have had a reasonable expectation of success, and that determined from the vantage point of the artisan at the time the invention was made. *Amgen, Inc. v. Chugai Pharm. Co.*, 927 F.2d 1200, 1209 (Fed. Cir. 1991).
3. The prior art reference or combination of references must teach or suggest all the limitations of the claims. *In re Vaeck*, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991); *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970).

The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, the nature of a problem to be solved. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). Alternatively, the motivation may be implicit from the prior art as a whole, rather than expressly stated. *Id.* Regardless if the USPTO relies on an express or an implicit showing of motivation, the USPTO is obligated to provide particular findings related to its conclusion, and those findings must be clear and particular. *Id.* A broad conclusionary statement, standing alone without support, is not “evidence.” *Id.*; *see also, In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001).

In addition, a rejection cannot be predicated on the mere identification of individual components of claimed limitations. *In re Kotzab*, 217 F.3d 1365, 1371 (Fed. Cir. 2000). Rather, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed. *Id.* In the Response to Arguments section of the July 1, 2003 Final Office Action, the Examiner completely avoids traversal arguments raised by Applicant in the May 29, 2003 Response Under 37 C.F.R. § 1.111. The Examiner is required to reply to all traversal arguments raised by the Applicant. *See* MPEP § 707.07(f) (“Where the applicant traverses any rejection, the Examiner should ... take note of the applicant’s argument and answer the substance of it.”). Specifically, the Examiner has failed to substantively rebut Applicant’s traversal arguments with respect to (i) the Examiner’s reliance on Figure 6 of Furuya, and (ii) the Examiner’s reliance on a foreign patent document without first obtaining a translation of that document. The reasons supporting Applicant’s position are discussed in turn below.

Furuya fails to teach or suggest that the wire resistance of a ground wire portion between an electrostatic protection element and a ground terminal is larger than a wire resistance of the ground wire portion between the electrostatic protection element and a MOS capacitor, as recited in independent claims 1 and 21. In Figure 6 of Furuya, there is no indication that the MOS device (609) is positioned relative to a capacitor (613) such that the resistive relationship as recited in claim 1 is taught or suggested. The Examiner asserts that Figure 6 of Furuya shows the claimed resistive relationship based on the positioning of the MOS device (609) along a ground wire relative to the capacitor (613) and a ground terminal (606). Figure 6 of Furuya cannot, however, support an

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obviousness rejection. “When the reference does not disclose that the drawings are to scale and is silent as to dimensions, arguments based on measurement of the drawing features are of little value.” MPEP § 2125. “[I]t is well established that patent drawings do not define the precise proportions of the elements and **may not be relied** on to show particular sizes if the specification is completely silent on the issue.” MPEP § 2125 *quoting Hockerson-Halberstadt, Inc. v. Avia Group Int’l*, 222 F.3d 951, 956 (Fed. Cir. 2000) (*emphasis added*). “Absent any written description in the specification on quantitative values, arguments based on measurement of a drawing are of little value.” *In re Wright*, 193 U.S.P.Q. 332, 335 (C.C.P.A 1977).

The Examiner states that Figure 6 of Furuya shows that the “wire resistance of the ground potential between the ESD element connection point and the ground terminal 606 is larger than that between the ESD element connection point and the capacitor’s connection point, because a wire resistance is directly proportional to the length of the wire, and the **distance between the ESD element connection point and the ground terminal 606 is larger than that between the ESD element connection point and the capacitor’s connection point.**” *See* July 1, 2003 Final Office Action, pg. 4, numbered paragraph 4 (*emphasis added*). Although the Examiner claims that he is not relying “on figure 6 of Furuya to teach the precise proportions of the elements,” the above emphasized quotation from the July 1, 2003 Final Office Action makes it abundantly clear that the Examiner is **relying** on Figure 6 of Furuya as allegedly supplying the necessary teaching for the claimed resistive relationship. *Hockerson-Halberstad* and *Wright* require the Examiner to support his distance allegations with citations from Furuya’s underlying text document regarding the distances between the component connections illustrated in Figure 6 of Furuya. However, since the

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Examiner has failed to obtain a translation of Furuya, the potential avenue of support afforded by *Hockerson-Halberstad* and *Wright* is foreclosed. Without the requisite translation of Furuya, the Examiner is *without* a description of quantitative values that would support the § 103(a) rejection based on Figure 6 of Furuya. *See Wright*, 193 U.S.P.Q. at 335.¹

In re Olson, 101 U.S.P.Q. 401 (C.C.P.A 1954) directly contravenes the Examiner's argument with respect to Figure 6 of Furuya as well. In *Olson*, a putative patentee attempted to amend a pending application based on the drawings included with the application. The *Olson* court found that a drawing having dimensions on the order of a few thousandths of an inch could not be scaled off to show that any particular distances or sizes are exactly equal when the specification was completely silent. *Olson*, 101 U.S.P.Q. at 403. Figure 6 of Furuya illustrates a semiconductor device, and it is well known that such devices involve measurements in the millionths of meters. Under *Olson*, the Examiner would have to rely on the underlying text document of Furuya in order to support his distance assertions with respect to Figure 6 of Furuya. However, without a translation of Furuya, *Olson* forecloses the Examiner's reliance on Figure 6 of Furuya.

¹ The initial burden of establishing that a claimed invention is *prima facie* obvious rests on the U.S. Patent and Trademark Office. *In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984). The U.S. Patent and Trademark Office is required to apply the law "in accordance with statute and precedent." *In re Lee*, 61 U.S.P.Q.2d 1430, 1435 (Fed. Cir. 2002). The Patent Office is obligated under the Administrative Procedures Act to develop an evidentiary basis for its findings. *Id.* at 1434. As discussed *supra*, without a translation of the underlying text document of Furuya, the Examiner cannot use Figure 6 to reject independent claims 1 and 21. Moreover, the burden is on the Examiner to make the *prima facie* case of obviousness, and the record must be complete. *See* MPEP § 706.02. In the instant application, the record is incomplete since no translation of Furuya has been obtained, and it is not Applicant's burden to obtain the translation. *See* MPEP § 706.02. Without a translation of the underlying text document of Furuya, the Examiner has no objective support for the rejection of independent claims 1 and 21.

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Furthermore, it is plainly evident that the Examiner is relying upon the Abstract and only Figure 6 of Furuya to support the 35 U.S.C. § 103(a) rejection of claims 1, 3, 8, 10, 12, 21-23 and 25-32, without considering the teachings of the underlying text of Furuya. "Citation of and reliance upon an abstract without citation of and reliance upon the underlying scientific document is generally inappropriate where both the abstract and the underlying document are prior art." MPEP § 706.02 (citing *Ex parte Jones*, 62 U.S.P.Q.2d 1206, 1208 (Bd. Pat. App. & Inter. 2001) (unpublished)). It is incumbent upon the Examiner to obtain a translation of Furuya so that the record is clear as to the precise facts the Examiner is relying upon in support of the rejection. See MPEP § 706.02. The record is also not clear whether the Examiner is relying only upon the Abstract for Furuya or other text in the disclosure of Furuya to support the 35 U.S.C. § 103(a) rejection of claims 1, 3, 8, 10, 12, 21-23 and 25-32. MPEP § 706.02 states in unambiguous language that the full text document might "include teachings away from the invention that will preclude an obviousness rejection under 35 U.S.C. 103, when the abstract alone appears to support the rejection." The Examiner cannot simply use the Abstract and Figure 6 of Furuya to reject claims 1, 3, 8, 10, 12, 21-23 and 25-32 without first making a determination that the disclosure of Furuya does not teach away from the claimed invention.

Thus, since the Examiner is improperly relying on the Abstract and Figure 6 of Furuya to reject the claimed resistive relationship between the recited elements, Applicant believes that the "all limitations" prong of a *prima facie* case of obviousness has not been satisfied as required by *In re Vaeck*. Applicant believes that independent claims 1 and 21 are allowable over Furuya, and

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Applicant further believes that claims 3, 8, 10, 12, 22, 23 and 25-32 are allowable as well, at least by virtue of their dependency from claims 1 and 21, respectively.

Since *Hockerson-Halberstad* and *Wright* foreclose the Examiner from relying upon Figure 6 of Furuya, motivation to modify Figure 6 of Furuya with a MOS capacitor is lacking as well. *In re Dembiczak* and *In re Zurko* require the Examiner to provide particularized facts on the record as to why one of skill would be motivated to modify Furuya with a MOS capacitor. Without a motivation to modify, a rejection based on a *prima facie* case of obviousness is improper. *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998)). The level of skill in the art cannot be relied upon to provide the suggestion to modify a reference. *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308 (Fed. Cir. 1999). The Examiner must make specific factual findings with respect to the motivation to modify a reference. *In re Lee*, 277 F.3d 1338, 1342-44 (Fed. Cir. 2002). Here, motivation is completely lacking since Furuya cannot be properly relied upon to support the obviousness rejection (See above discussion with respect to the “all limitations” prong of a *prima facie* case of obviousness). Without a reference to modify, the motivation prong of a *prima facie* case of obviousness cannot be fulfilled, as required by *In re Dembiczak* and *In re Zurko*.

Thus, since the motivation prong of a *prima facie* case of obviousness has not been satisfied, Applicant believes that independent claims 1 and 21 are allowable over Furuya, and Applicant further believes that claims 3, 8, 10, 12, 22, 23 and 25-32 are allowable as well, at least by virtue of their dependency from claims 1 and 21, respectively.

New claims 33 and 34 have recitations that are similar to claims 1 and 21, respectively. More specifically, new claims 33 and 34 both recite that the wire resistance of a ground wire portion

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between an electrostatic protection element and a ground terminal is larger than a wire resistance of the ground wire portion between the electrostatic protection element and a MOS capacitor. Applicant believes that new claims 33 and 34 are allowable for at least the same reasons as independent claims 1 and 21, in that Furuya does not teach or suggest the claimed resistive relationship between the recited elements. Applicant believes that claims 33 and 34 are allowable of Furuya.

4. Claims 9 and 24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Furuya in view of Merritt (U.S. Patent No. 4,786,956). Applicant traverses the rejection of claims 9 and 24 for at least the reasons set forth below.

The Examiner combines Merritt with Furuya in an attempt to overcome the deficiencies of Furuya with respect to the power source conversion circuit recited in claims 9 and 24. Claim 9 includes all the recitations of claim 1 by virtue of its dependency, and claim 24 includes all of the recitations of claim 21 by virtue of its dependency.

The Examiner has failed to cite any passage in Merritt that teaches or suggests the claimed resistance relationship between an electrostatic protection device and a capacitor, as recited in independent claims 1 and 21, and included in claims 9 and 24 via dependency. For the same reasons as discussed above with respect to claims 1, 3, 8, 10, 12, 21-23 and 25-32, the combination of Furuya and Merritt fails to teach or suggest the claimed resistive relationship. Applicant believes that the “all limitations” prong of a *prima facie* case of obviousness has not been satisfied, as required by *In re Vaeck*.

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Applicant submits that the Examiner has failed to make a *prima facie* case of obviousness as required by *Piasecki*. The Examiner has not made any findings on the record, as required by *Dembiczak*, as to why one of ordinary skill in the art would be motivated to combine Furuya and Merritt, especially when Merritt lacks any teaching whatsoever with respect to the claimed resistive relationship and *Hockerson-Halberstad* precludes the use of Figure 6 of Furuya. Applicant believes that the motivation prong of a *prima facie* case of obviousness has not been satisfied.

Thus, since the combination of Furuya and Merritt fail to meet the “all limitations” and motivation prongs of *prima facie* case of obviousness, Applicant believes that claims 9 and 24 are allowable over the combination of Furuya and Merritt.

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In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

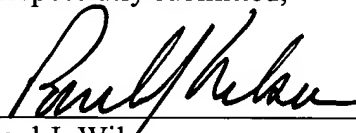
SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

23373

CUSTOMER NUMBER

Respectfully submitted,


Paul J. Wilson
Registration No. 45,879

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